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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional):

4123-004

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Date: **August 23, 2006**

Signature:

Typed or printed name: **KATHLEEN KOPPEN**

Application Number:

09/902,834

Filed:

July 10, 2001

First Named Inventor:

Chu

Art Unit:

3765

Examiner:

DANNY WORRELL

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request

This request is being filed with a notice of appeal.

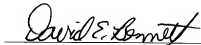
The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor



Signature



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

(Form PTO/SB/96)

David E. Bennett

Typed or Printed Name



attorney or agent of record

Registration Number: 32,194**(919) 854-1844**

Telephone Number



attorney or agent acting under 37 CFR 1.34.

Registration Number if acting under 37 CFR 1.34 _____

August 23, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.



*Total of _____ form(s) is/are submitted.

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. * Applicant's unique citation designation number (optional). * Applicant is to place a check mark here if English language translation is attached. This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Chu

Serial No.: 09/902,834

Filed: July 10, 2001

For: Active Labels for Products

Docket No: 4123-004

PATENT PENDING

Examiner: Danny Worrell

Group Art Unit: 3765

Confirmation No.: 9863

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CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

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August 23, 2006

Date

Kathleen Köppen

This correspondence is being:

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Sir:

ARGUMENTS PRESENTED FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

The applicant presents the following arguments in support of the Pre-Appeal Brief Request for Review which is attached herewith.

Applicant's invention relates to a digital label that functions as a replacement for conventional woven and fabric labels. The label comprises an electronic display and a programmable circuit programmed to output information. Claims 1 and 9 specify that the output information comprises product information about the product to which the label is attached. Claim 1 further specifies that the output information is animated. Claims 29 and 47 specify that the output information is product information or source information.

Claims 1-15, 18, 19, and 22-46 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner asserts that the phrase "wherein the electronic display is not associated with the inherent function of the product" is indefinite. On the contrary, the recited

language is intended to limit the scope of the invention to products that do not normally have a display. Products that normally have a display, such as cell phones and computers, are excluded from the scope of the claims. This language, when read in light of the specification, would be readily understood by those skilled in the art and is as precise as the English language allows. The Examiner argues that the claim is contradictory on its face because the display outputs information about the product and is therefore associated with the inherent function of the product. The Examiner has simply confused the issue. The display may output information concerning the product, but the display itself is not required as part of the inherent function of the product. Accordingly, Applicant does not believe that the language is indefinite.

The Examiner further asserts, with regard to independent claim 29, that the recitation of "label information, product information, or source information" renders the claim indefinite since the product is not being claimed as part of the invention. Applicant concurs that the product itself is not being claimed. However, the product is recited in the claim to provide context for the invention. There is nothing improper about making reference to unclaimed elements as a way of defining a claimed element. In this case, the reference to product information simply serves to define the type of the output information, which is being claimed.

Independent claims 1 and 29 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Gomersall, U.S. Patent No. 4,500,880. Gomersall, however, does not disclose all of the limitations of claim 1. The claim refers to a base adapted to be affixed to a product. The claim further recites an electronic display and a programmable circuit programmed to output information about the product to the display. Clearly, the reference to product in the definition of the output information refers to the product to which the base is attached. Thus, according to the plain language of claim 1, the programmable circuit must output information about the product to which the label is attached. The display device disclosed in Gomersall attaches to a display shelf on which other products can be displayed. The information displayed (e.g., price information)

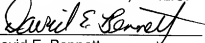
concerns the products displayed on the display shelf, not about the display shelf. Therefore, Gomersall does not satisfy the limitation in the claim that the displayed information relate to the product to which the label is attached. Moreover, claim 1 requires that the information be animated. The display device in Gomersall does not display animated images. The Examiner simply ignores this limitation.

Claims 1, 9, 29, and 47 were also rejected as being anticipated by Fitch, U.S. Patent No. 5,912,653. Fitch discloses a display that can be attached to a garment to display video. The video display provides a means of self expression. There is no suggestion in Fitch to use the display to display information about the product or its source. All of the claims recite a programmable circuit programmed to output product and/or source information. Because Fitch does not even suggest displaying product or source information as recited in the claims, Fitch cannot anticipate the claims.

For the foregoing reasons, the Board is respectfully urged to return the application to the Examiner for further prosecution.

Respectfully submitted,

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Dated: August 23, 2006

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